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REMARKS

Claims 1-10 and 12-22 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1-10 and 12-22 Under 35 U.S.C. §103(a)**

Claims 1-10 and 12-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Li et al.* (US 5,672,858), in view of *Clark et al.* (US RE37,635). Withdrawal of this rejection is respectfully requested for at least the following reasons. The combination of *Li et al.* and *Clark et al.* does not teach or suggest each and every limitation set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicant's claimed invention relates to a portable image collecting module operable to read one-dimensional, two-dimensional and hybrid dataforms. The image collecting module comprises an indicator system and method that provides a user with indication of either a valid read, or an invalid read of: one-dimensional, two-dimensional and hybrid dataforms. Independent claim 1 (and associated dependent claims) recites: *a first multicolor photo indicator* to provide an indication of a valid read of a first portion of a hybrid dataform; and a second indicator to provide an indication of a valid read of a second portion of the hybrid dataform. Further, independent claims 13 and 20, and claims that depend there from, respectively recite a method and a means for effectuating

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the invention as claimed. It is apparent that the claimed invention utilizes a first *multicolor photo indicator* to apprise a user of the validity, or invalidity of, a first portion of a hybrid dataform by the image collecting module. Li *et al.* and Clark *et al.*, either alone or in combination, fail to teach or suggest this exemplary aspect of the claimed invention.

In the Final Office Action (dated August 9, 2004), the Examiner concedes that Li *et al.* fails to provide the user, through the utilization of a first multicolor photo indicator, an indication that a hybrid dataform has been successfully read. Thus, in an attempt to rectify this deficiency, the Examiner offers Clark *et al.* as providing the necessary teaching or suggestion to satisfy the Examiner's burden under 35 U.S.C. §103(a). The Examiner in particular indicates that support can be found at col. 3, line 65-col. 4, line 4, of Clark *et al.* Applicant's representative submits that the noted passage, rather than providing a first multicolor photo indicator to apprise the user of a successful read of a hybrid dataform, provides a single *monochromatic* light emitting diode to indicate to an operator that a bar code symbol has been successfully decoded.

In addition, to further substantiate the assertion that Clark *et al.* renders obvious applicant's claimed invention, the Examiner, in the Response to Arguments section of the Final Office Action (dated August 9, 2004), provides Leister (US 5,196,686), col. 2, lines 37-52, as disclosing a LED capable of being a multicolor indicator. However, as was stated by applicant's representative in the Reply to the Final Office Action, and is reiterated herein, Leister utilizes a *pair of indicator lights*, not a single *multicolor photo indicator* to provide an indication of a valid read of a first portion of a hybrid dataform, as is recited in the subject claims. It is therefore apparent that Leister does not teach or suggest the first multicolor photo indicator of the subject claims, but instead provides two separate and distinct lights to indicate whether or not a good or bad read has taken place. It is thus submitted that Leister fails to provide the evidentiary substantiation for which the Examiner cites the document.

With respect to independent claims 21 and 22, which recite the utilization of audio, visual, and vibration signals to indicate the read status of hybrid dataforms. The Examiner in the Final Office Action (dated August 9, 2004) rejects these claims out of hand, claiming that the use of sound/vibration indication means are functionally

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equivalent to a LED means, and therefore would by extension have been obvious in view of *Li et al.* As was stated in the Reply to Final Office Action, applicant's representative contends that the Examiner is conflating the distinctions between human sensory perceptions, i.e., sight, smell, sound, taste and touch, in order to obfuscate the novelty of applicant's claimed invention, and thus has embarked on an exercise in sophism. Further, the Examiner is reminded that in order to establish obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). In view of the fact that the Examiner is unable and/or unwilling to elucidate substantive evidentiary support within the documents provided, but instead resorts to the utilization of functional equivalents, is a clear indication that the cited documents are devoid of the necessary teaching or suggestion to ground an appropriate rejection under 35 U.S.C. §103.

Moreover, the Examiner is further counseled that an additional requirement for an obviousness rejection under 35 U.S.C. §103, is that the teaching or suggestion must be found within the prior art and not on the applicant's disclosure. *See e.g., In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991). In light of the fact that the Examiner has been unable to locate documents that directly or indirectly teach or suggest the utilization of tactile, audio and/or visual stimuli to indicate the appropriate read status of a hybrid dataform, and further in view of the Examiner's own admission that *Li et al.* fails to disclose or fairly suggest that the indication means of the reader are LEDs (i.e. photo, illumination, lights) or vibration signals for indicating a valid read, it is incomprehensible to applicant's representative's mind, how the use of sound/vibration indicating means can be functionally equivalent to an entity that the Examiner concedes is not disclosed in the cited documents. It is thus submitted, since *Li et al.* fails to fairly teach or suggest a LED means, the Examiner is impermissibly attempting to utilize applicant's specification as a 20/20 hindsight-based roadmap to achieve the purported combination; an exercise that the Court of Appeals for the Federal Circuit has condemned. *See e.g., Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the foregoing, and since neither *Li et al.* nor *Clark et al.*, either individually or in combination, contemplate the invention in its entirety as set forth in the

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subject claims, it is requested that the rejection of independent claims 1, 13, 20, 21 and 22, and associated dependent claims, be withdrawn.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731